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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,852	12/14/2000	Axel Schamal	225/49355	5694

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EXAMINER	
REIS, TRAVIS M	

ART UNIT	PAPER NUMBER
2859	

DATE MAILED: 02/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/674,852	SCHAMAL, AXEL	
	Examiner	Art Unit	
	Travis M Reis	2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 October 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-6 and 8-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-6 and 8-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 3, 4, & 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over in Hall (U.S. Patent 2419134) view of Murkens (U.S. Patent 4680869).

Hall discloses, in Figure 3, a device utilizable in holes (28) comprising a screw/spike (61) with screw threads on its upper part, an attachment element (4) which can be connected releasably to the screw/spike via its own screw threads and rests (3) on the component surface, wherein the attachment element has a partially spherical shell (1) made of non-magnetic material (Figures 1, 3, & 8).

Hall does not disclose an insert arranged within the shell and made of magnetic material, wherein a lower edge of the shell bears substantially flush against a lower side of the insert.

Murkens discloses a cylindrical square (12) with a magnetic insert (32) (Figure 5) (col. 2 line 42) which is adapted have other components pass through the insert for applying the square to vertical surfaces (Figure 1). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the magnetic insert disclosed by Murkens to the shell disclosed by Hall in order that the shell can stably locate holes in vertical surfaces, and since the stably locating means claimed by Applicant and the stably locating means used by Hall & Murkens are well known alternate types of stably

locating means which will perform the same function, if one is replaced with the other, of stably locating holes.

Hall does not disclose expressly the device is used for determining the position of or for measuring a hole in a body part of a motor vehicle. However, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. ***Ex parte Masham***, 2 USPQ2d 1647 (1987).

3. Claims 5, 8-10 rejected under 35 U.S.C. 103(a) as being unpatentable over Hall in view of Murkens as applied to claims 1, 3, 4, & 6 above, and further in view of Holmes (U.S. Patent 4220187).

Hall & Murkens disclose all of the instant claimed invention as stated above in the rejection of claims 1, 3, 4, & 6, but do not disclose expressly a spike fastened to the attachment element in an asymmetrical manner with respect thereto.

Holmes discloses a self-locking fastener with an attachment element/nut (12) to which the bolt (10) fastens to in an asymmetrical manner with respect thereto (Figures 1-3, 5, & 7). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to replace the attachment element taught by Hall & Murkens with the asymmetric attachment element/nut disclosed by Holmes in order that the spike could be locked into place of the attachment element.

Response to Arguments

4. Applicant's arguments filed that the addition proposed by examiner e.g. the magnetic second hollow cylindrical member 32 disclosed by Murkens to the ball like portion of the Hall locator; these arguments have been fully considered but they are not persuasive since the Hall patent makes no mention of stably locating holes in a vertical plane, and since magnetic

stable locating means are alternate means to the stable locating means disclosed by Hall the use of magnetic means would be an obvious engineering choice.

5. In response to applicant's argument that there is no suggestion to combine the references i.e. the addition of the magnetic second hollow cylindrical member 32 of the permanent magnet assembly 33 disclosed by Murkens to the ball like portion 1 of the Hall locator is inappropriate, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the features of the magnetic hollow cylindrical member disclosed by Murkens present numerous obvious advantages to the Hall locator to one sufficiently motivated to improve the Hall locator i.e. allow stable location to take place in a vertical plane by alternate means than those presented in the Hall patent in the horizontal plane.

6. Applicant's arguments filed that the Murkens patent does not have the feature disclosed by Applicant of determining the position or size of a hole, these arguments have been fully considered but they are not persuasive since the Murkens patent is only relied on to teach the feature of a magnetic element. The feature of determining the position or size of a hole is already taught by the prior art of the Hall patent, and hence this feature is unnecessary to be taught by the Murkens patent.

Conclusion

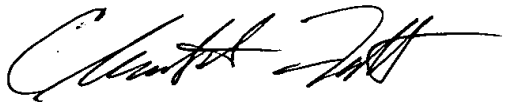
7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis M Reis whose telephone number is (703) 305-4771. The examiner can normally be reached on 8--5 M--F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (703) 308-3875. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for all communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Travis M Reis
Examiner
Art Unit 2859

Diego Gutierrez
Supervisory Patent Examiner
Technology Center 2800

tmr
February 3, 2004